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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,273	03/16/2004	Jaime E. Garcia	JK01488A	2972
28368 7590 05/04/2009 THE BLACK & DECKER CORPORATION 701 EAST JOPPA ROAD, TW199 TOWSON, MD 21286				
EXAMINER LANDRUM, EDWARD F				
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05/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,273

Applicant(s)

GARCIA ET AL.

Examiner

Edward F. Landrum

Art Unit

3724

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7, 34, and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Based on Figure 6 and the claim language related to the gear housing and the raised and lowered positions of the cutting assembly it is not understood how the portion of the gear housing that is directly below the motor shaft (644P) is always above the arbor. If the device were beveled 45 degrees counter clockwise from the position shown in Figure 6 the lowermost exposed portion of the housing directly below the motor shaft would no longer be above the arbor. Furthermore, what portion of the motor shaft is the lowermost portion of the housing directly below of?

Claim Rejections - 35 USC § 103

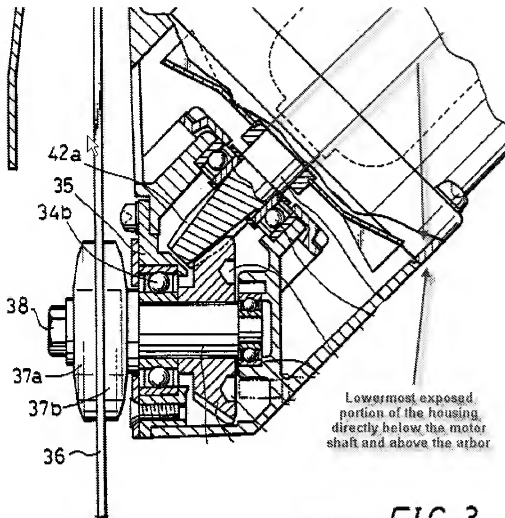
3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 4, 6, 7, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ito et al (U.S Patent No. 5,357834), hereinafter Ito, in view of Hum et al (U. S

Patent No. 5,850,698), hereinafter Hurn, in witness of Drake (U.S Patent No. 2,340,312).

Regarding claim 1, Ito teaches (see Figures 1-3) a miter saw (1) comprising a base (2) having a substantially horizontal turn-table/support surface (3), a work piece positioning fence (6) attached to the base (2), and a cutting assembly (21) pivotally attached to the miter saw. The cutting assembly is pivotable between a raised and a lowered position (see Figures 1 and 2). A motor (41) is drivingly connected to the arbor (33) of the saw blade (36) and configured so as to not contact any portion of the base or fence (6) when the mitering at least 45 degrees from a plane substantially perpendicular to the work piece positioning fence (see Figure 2; Col. 6, lines 1-20). The motor (41) has a motor shaft (42) and a gear assembly (42a and 39) that transfers rotational motion from the motor shaft (42) to the arbor (33). A gear housing (32 and 35) covers the motor shaft, arbor, and gears, and has a lowermost exposed portion directly below the motor shaft (42) and above the arbor when the cutting assembly in the lowered position (see Modified Figure 3 below). The arbor (33) does not extend beyond the motor shaft (42). The gear (39) connected to the arbor (33) is a bevel gear. A blade guard (31) surrounds the blade.



Drake teaches (Figure 2 and 3) that it is inherent in the design of an electric motor that the motor shaft (27 and 28) extends through the motor as this is required for the motor shaft to rotate do to the electromagnetic current created within the motor. Figure 2 of Ito teaches similar structure without explicitly stating it.

Regarding claim 4, Ito teaches (see Figure 3) the gear housing/box (32 and 35) tapers in a direction of the base.

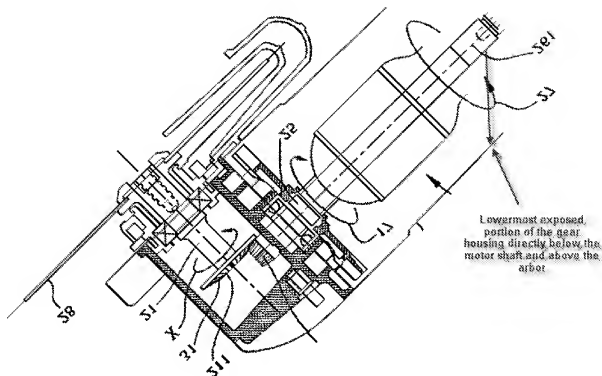
Regarding claim 7, Ito teaches (see Figure 1) the miter saw is a slide-type miter saw.

Ito teaches all of the elements of the current invention as stated above except the use of a gear assembly and a motor orientated substantially perpendicular to the arbor of the saw.

Hurn teaches (see Figure 2) a motor (15) oriented substantially perpendicular to an arbor (21) in a circular saw while still not allowing the arbor to extend beyond the motor shaft. A gear assembly is used to transfer the rotational power of the motor to the saw blade (28). Hurn also teaches (Figures 2 and 3) a portion of a gear housing being behind the arbor (21) and also being an exterior surface adjacent the flat surface of the shoe (300).

It would have been obvious to have modified Ito to incorporate the teachings of Hurn to use an established method of transferring the rotational motion generated by the motor to the saw blade while still allowing the saw blade to bevel to the degree that was originally presented by Ito.

Replacing gear and motor configuration of Hurn in combination with Ito still teaches the limitation of an outer lower most exposed portion of the gear housing being directly below the motor shaft closest to a support surface and above the arbor See modified Figure 2 of Hurn below. The Figure has been reversed and rotated 45 degrees clockwise, which is a possible lowered position of the cutting assembly.



Modified Figure 2

Furthermore, Ito teaches the criticality of allowing the cutting assembly to pivot 45 degrees without contacting the positioning fence (Col. 6, lines 14-19) therefore an outer lowermost exposed portion directly below the motor shaft and closest to the support surface being above the arbor presents no novel or unexpected result over the motor/gear configuration and gear housing of Ito. Use of such a position of the lowermost exposed portion in lieu of the configuration used in Ito would be an obvious matter of design choice to one of ordinary skill in the art.

5. Claims 2, 3, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified device of Ito, as stated in section 4, in view of Avakian (U.S Patent No. 3,611,859) or Allemann (U.S Patent No. 2,925,104).

The modified device of Ito teaches all of the elements of the current invention as stated above except for the gear assembly containing a helical and bevel gears as well as a jackshaft. The jack shaft being rotatably connected to the second bevel gear and a helical gear set disposed between the jack shaft and the motor shaft.

Avakian teaches (Col. 2, lines 20-27) a first helical gear that is mounted to a rotating shaft. The first helical gear rotates a second helical gear that is attached to a jack shaft. The jack shaft is attached to a bevel gear which drives a gear box.

Allemann teaches (see Figure 1) a first helical gear (22), which is mounted to a motor shaft (20) that drives a second helical gear (24). The second helical gear drives a jack shaft (26) that in turn rotates a second bevel gear (52) attached to the jack shaft (26). The second bevel gear (52) meshes with a first bevel gear (54) that is mounted to an arbor (50) to rotate a saw (46).

It would have been obvious to have modified the modified device of Ito to incorporate the teachings of Avakian or Allemann to incorporate a helical/bevel gear assembly with a jack shaft between each assembly for the purpose of transferring rotational motion generated by the motor, which is offset from the rotational axis of the saw, to the arbor and still allow the location of the motor to not interfere with the ability of the saw to bevel. This would allow a user to move the motor, which could burn or

shock a user if touched, away from any location that a user would normally touch on the saw.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified device of Ito, as stated in section 4, in view of Hollinger et al (U.S Patent No. 6,615,701), hereinafter Hollinger.

The modified device of Ito teaches all of the elements of the current invention as stated above except for a trunnion being disposed between the cutting assembly and the turntable so as to permit the cutting assembly to bevel with respect to the base.

Hollinger teaches (Col. 4, lines 50-51; also see Figure 4) a trunnion (32) mounted between the base and the cutting assembly.

It would have been obvious to have modified the modified device of Ito to incorporate the teachings of Hollinger to use a trunnion for the purpose of allowing the cutting assembly to easily be moved to different angular orientations with respect to the base so a user could use the saw to make a variety of different cuts.

Response to Arguments

7. Applicant's arguments with respect to claims 1-7, 34 and 35 have been considered but are moot in view of the new ground(s) of rejection.

Both Ito and Hum teach a lowermost exposed portion of a gear housing directly below the motor shaft and above the arbor as this limitation appears to be dependent on the bevel angle of the cutting assembly which has not been claimed.

Regarding applicant's argument that the configuration of the instant application allows for the cutting of bigger or taller work pieces this is an opinion. The lowermost

portions of the gear housing of the instant application (Figure 6) and Ito (Figure 3) are nearly identical in shape. Examiner contends that both could cut work pieces of similar sizes. Furthermore, changing the form or shape of a structure without thereby changing how the device is used or functions has been held to be an obvious matter of design choice to one of ordinary skill in the art.

Examiner recommends incorporating more structure found within the gear housing to the independent claim as well as more explicitly defining the location of the cutting assembly when discussing the location of the exposed portion of the housing directly below the motor shaft.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Stumpf et al (U.S Patent No. 5,943,931), Brunson et al (U.S Publication No. 2001/0042429), Brunson (U.S Patent No. 6,474,206), Sasaki et al (U.S Patent No. 5,564,323), Bergler (U.S Patent No. 4,537,105), Itzov (U.S Patent No. 5,865,079), and Mckeage (U.S Patent No. 1,803,068) all teach miter saws including various elements of the disclosed invention.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3724

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to lb whose telephone number is 571-272-5567. The examiner can normally be reached on Monday-Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/E. F. L./

Examiner, Art Unit 3724

4/29/2009

/Boyer D. Ashley/

Supervisory Patent Examiner, Art Unit 3724